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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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01/16/2004

Kevin R. Orton

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EXAMINER

PATTON, AMANDA K

ART UNIT

PAPER NUMBER

3709

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/759,850

Applicant(s)

ORTON, KEVIN R.

Examiner

Amanda Patton

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3709

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 1-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/16/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Claims 32-42 are withdrawn from further consideration. Applicant's election without traverse of Group II, claims 43-63 in the reply filed on June 15, 2007, is acknowledged.

Specification

The disclosure is objected to because of the following informalities: The disclosure does not mention a conductor adapted to conduct "an ionic current of ions" as mentioned in Claim 43. Appropriate correction is required.

Claim Objections

Claim 63 is objected to because of the following informalities: Claims are required to be placed in the form of a single sentence. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 43-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 43, the claim mentions a conductor adapted to "conduct an ionic current of ions". This phrase is unclear, does not have any definite meaning in the art, and is not clearly defined in the specification. For purposes of examination, the term, "adapted to conduct an ionic

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current of ions” has been taken to mean “adapted to conduct an electric charge.” Appropriate clarification is required.

Regarding claim 58, it is unclear what amount of time is sufficient to result in substantial electrically triggered weight loss.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 43-63 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10-30 of U.S. Patent No. 6,694,185 (hereafter referred to as ‘185).

Claims 43 recites a garment for reducing weight in a patient (line 1 of claim 10 of ‘185), comprising: a conductor (line 3 of claim 10) adapted to be placed in direct contact with a first

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skin surface of the patient (lines 4-5 of claim 10) and adapted to conduct an ionic current of ions that occur naturally in the patient (lines 11-12 of claim 10), wherein the conductor is adapted to be located proximal to a subcutaneous fatty deposit (line 5-6 of claim 10).

Although there are some differences between claim 43 of the instant application and claim 10 of '185, as shown below these differences are not patentably distinct:

- Claim 43 of the instant application and claim 10 of '185 is the term "conductor" of the instant application and the term "low-resistance electrically conductive material portion".
The term "conductor" is merely broader than the term "low-resistance electrically conductive material portion" and the specific term "low-resistance electrically conductive material portion" anticipates the broader term "conductor".
- Claim 43 of the instant application and claim 10 of '185 is the phrase "adapted to conduct an ionic current of ions" of the instant application and the phrase "adapted to conduct an electric charge". As the phrase "adapted to conduct an ionic current of ions" of claim 43 is unclear, does not have a definite meaning in the art, and has not been properly defined in the specification, it has been assumed, using the description in the specification, to have the same meaning as "adapted to conduct an electric charge."
- Additionally, a low-resistance electrically conductive material portion is adapted to directly contact a first skin surface of the patient, the first skin surface being proximal to a fatty deposit in the patient, (claim 10 of '185), it is inherent that the conductor is adapted to be located proximal to a subcutaneous fatty deposit and is also adapted to be placed in direct contact with a first skin surface (claim 43 of the instant application).

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- Claim 10 of '185 additionally teaches a support portion not mentioned in claim 43 of the instant application. This simply means the instant application is broader in this respect and does not preclude a double patenting rejection, as the more specific claim 10 of '185 anticipates the broader claim 43 of the instant application.

Claim 44 of the instant application recites a garment for reducing weight in a patient as stated in claim 43, additionally comprising a support portion, wherein the support portion is adapted to maintain the conductor in direct contact with a first skin surface of the patient. Claim 10 of '185 additionally teaches a support portion adapted to maintain the low-resistance electrically conductive material in direct contact with the first skin surface (lines 7-9).

Numerous other claims dependent from claim 43 in the instant application are anticipated by '185.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 43-48 and 60-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Stoddard (US Pat. 6,014,585).

Regarding **claims 43 and 44**, Stoddard teaches a conductor 2 and a protective material support portion 1 (Figure 1 and Col. 2 @ 50-60). While Stoddard does not teach a garment for reducing weight, the conducting tape of Stoddard is capable of performing all of the functional limitations of claims 43 and 44, including comprising: a conductor that is capable of being placed in direct contact with a skin surface, a conductor that is capable of conducting an ionic current of ions that occur naturally in the patient, a conductor that is capable of being located proximal to a subcutaneous fatty deposit, and a support portion that is capable of maintaining the conductor in direct contact with a first skin surface of the patient proximal to the subcutaneous fatty deposit.

Regarding **claim 45**, Stoddard additionally teaches a conductor that may be repositioned to be located proximal to a subcutaneous fatty deposit and to avoid being located proximal to a bone joint.

Regarding **claim 46**, Stoddard additionally teaches a conductor that comprises a low-resistance electrically conductive material. This material is inherently capable of developing less than approximately 0.5 across the conductor and being able to cause an ionic current to flow from a first portion of the conductor to a second portion of the conductor.

Regarding **claim 47**, Stoddard additionally teaches a conductor that has a resistance of 10 ohm/in². This is less than 10,000 ohms/in² (Col. 3 @15-20).

Regarding **claim 48**, Stoddard additionally teaches a conductor that is capable of being positioned to create a current flow path between the end of two bones.

Regarding **claim 60**, Stoddard additionally teaches conductor 2 that is capable of encompassing a naturally occurring electrical gradient in the patient. The phrase “wherein the patient comprises a central portion and an extremity extending from the central portion to a distal end of the extremity, and the first skin surface extends from a first position nearer to the central portion to a second position further from the central portion and nearer to the distal end” has been given little patentable weight as it does not further limit the claim.

Regarding **claims 61 and 62**, Stoppard additionally teaches conductor that comprises a flexible material coated or placed with an electrically conductive metal such as silver (Col. 2 @ 55-60).

Claims 43-44, 46, 49-51, 53, and 60-61 are rejected under 35 U.S.C. 102(a) and 102(e) as being anticipated by Maida (US Pat. 6,151,528).

Regarding **claims 43 and 44**, Maida teaches a device comprising conductive portion 13 and insulating portion 16 that acts both as an insulator and a support portion. While Maida does not teach a garment for reducing weight in a patient, the device of Maida is capable, in its current configuration, of performing all of the functional limitations of the instant invention, including comprising: a conductor that is capable of being placed in direct contact with a skin surface; a conductor that is capable of conducting an ionic current of ions that occur naturally in the patient; a conductor that is capable of being located proximal to a subcutaneous fatty deposit (placement of conductors 13 and 14 on or near the thigh of the patient as shown in Figure 1); and a support portion that is capable of maintaining the conductor in direct contact with a first skin surface of the patient, proximal to the subcutaneous fatty deposit (Col. 3 @ 1-45).

Regarding **claim 46**, Maida additionally teaches conductor portion 13 that comprises a low-resistance electrically conductive material that is capable of developing less than approximately 0.5 volts across itself when in use and is capable of causing an ionic current to flow from a first portion of the conductor to a second portion of the conductor.

Regarding **claim 49**, Maida additionally teaches an insulator 16 and a second conductor portion 14 to be placed in direct contact with a skin surface. Although Maida does not explicitly teach a garment adapted to create a second current flow path through a second subcutaneous fatty deposit, for a second electric charge naturally present in the patient, the invention disclosed in Maida would be capable of performing these functional limitations.

Regarding **claims 50 and 51**, Maida additionally teaches a garment wherein the insulator is adapted to be located along a skin contact surface and placed proximal to a bone joint (insulator 16 located proximal to the hip joint as shown in Figure 1). First conductor 13 is located proximal to a first bone (the hip bone) and second conductor 14 is located proximal to a second bone (the femur). The phrase “wherein the first skin surface is proximal to a first bone, the second skin surface is proximal to a second bone, and the first bone is connected to the second bone with a bone joint” has been given little patentable weight as it does not further limit the claim.

Regarding **claim 53**, Maida additionally teaches, as shown in Figure 1, a garment in which the insulator 16 is substantially smaller than either of the first conductor 13 or the second conductor 14.

Regarding **claim 60**, Maida additionally teaches conductor portion 13 that is capable of encompassing a naturally occurring electrical gradient in a patient. The phrase “wherein the

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patient comprises a central portion and an extremity extending from the central portion to a distal end of the extremity, and the first skin surface extends from a first position nearer to the central portion to a second position further from the central portion and nearer to the distal end" has been given little patentable weight as it does not further limit the claim.

Regarding **claim 61**, Maida additionally teaches an electrically conductive flexible cloth-like material (Col. 3 @ 25-40).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 52, 54-59, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maida.

Regarding **claim 52, 54, and 56**, Maida does not explicitly teach an insulator that is free from any contact with a first and second conductor, an insulator that separates the first and second conductor by approximately twelve millimeters, or a plurality of conductors and a plurality of insulators with gaps between the conductors every 6 to 18 in the direction extending outwards from a central portion of the patient to the distal end of an extremity of the patient. It would have been an obvious design choice, however, to one of ordinary skill in the art at the time the invention was made to include these design choices in order to provide a better fitting garment with small insulators and conductors allowing closer fit to the body.

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Regarding **claim 55**, although Maida does not explicitly teach an insulator that has a resistance of at least 10,000 ohms/in², it is well known in the art that a device meant to act as an insulator would have a resistance of at least 10,000 ohms/in².

Regarding **claim 57**, Maida additionally teaches a device with insulators capable of being played over a plurality of bone joints including the hip joint (Figure 1).

Regarding **claims 58 and 59**, Maida does not explicitly a conductor adapted to be worn for a period of time sufficient to result in substantial electrically triggered weight loss or that time being at least four hours per day for at least three days. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the garment of Maida for the time as describe in the present invention in order to provide a significant weight loss.

Regarding **claim 63**, while Maida does not explicitly teach a garment that is sold and merchandised as a particular type of product, it would have been obvious to one of ordinary skill in the art at the time the invention was made to sell and market the device of Maida as a weight loss device as it is capable of providing electrically-triggered weight loss. Additionally, this claim adds no further structural limitations to the preceding claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda Patton whose telephone number is (571) 270-1912. The examiner can normally be reached on Monday - Thursday, 8:30am - 5:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jackson can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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7/5/2007

GARY JACKSON
SUPERVISORY PATENT EXAMINER

Gary Jackson
7/5/07